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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,181	09/24/2001	Takuro Ikeda	1405.1050	7175
21171 7590 04/15/2009 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
CASLER, TRACI				
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3629				
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04/15/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/961,181

**Applicant(s)**

IKEDA ET AL.

**Examiner**

Traci L. Casler

**Art Unit**

3629

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

This action is in response to papers filed on January 15, 2009.

Claims 1, 2 and 9-10 have been amended.

Claim 7 has been cancelled.

Claims 1, 2, 4-6 and 8-11 are pending.

Claim 1, 2, 4-6 and 8-11 are rejected.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 1 in order for a method/process claim to fall within statutory subject matter the claims be tied to either a machine or transformation. A two-branched inquiry is used to show that a claims is statutory by either tying it to a particular machine or a by showing that the claim transforms an article. The use of a specific machine or transformation of an article must impose "meaningful limits" on the claims' scope to impart patent-eligibility. The involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity, such as storing, gathering, displaying, sending and receiving of data as this does not impart a significant impact in the solution to the process. See in re Bilski.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 20020128898 Smith JR et al; Dynamically assigning a survey to a respondent; in view of US Patent 6381744 Nanos et al; Automated Survey Kiosk. Hereinafter referred to as Smith and Nanos respectively.
4. As to claims 1, 2, 9 and 10 Smith Teaches a system, method and apparatus:
5. storing billing criteria for billing for transmitted dialogue scenarios (Pg 7 ¶113)

6. storing dialogue scenarios; **(Pg. 6 ¶ & Pg 7 ¶ 115 client can develop and save multiple surveys(scenarios) the automated survey mechanism determines the particular location where the survey will reside(store)**
7. storing first correspondences between each of the dialogue scenarios and one or more destination addresses;(storing information regarding surveys and manufacturing requesting surveys)**(Pg. 4 ¶ 59-66 client selects/defines survey(scenario) and information is stored as the client wants this survey)**
8. storing second correspondences between customer-identifying data and customer information;(as best understood by examiner) **(Pg. 7-8 mapping and storing network user information).**
9. accepting input of the customer-identifying data; **;(Pg. 8 ¶ 128 network user is required to enter certain pertinent information)**
10. extracting from the dialogue scenarios, a dialogue scenario to be performed **(Pg. 9 ¶ 145 dynamically identify and select a particular survey that is to be provided to respondent)**
11. holding a dialogue with a customer following the extracted dialogue scenario, the customer being identified based on the customer-identifying data; **(Pg. 9 ¶ 156 the identified survey is forwarded to client to allow respondent to participate).**
12. acquiring dialogue content from the dialogue; associating the extracted customer information with the dialogue content; transmitting the dialogue content and the customer information to the one or more destination addresses corresponding to the extracted dialogue scenario; **(Pg. 8 ¶ 132 results are process and analyzed to**

**generate survey data...the extraction of survey data is sent to the address that was previously specified by the client defining the survey).**

13. extracting customer information corresponding to the inputted customer-identifying data; according to the second correspondence extracting customer information corresponding to the inputted customer-identifying data **(Pg. 7 ¶ 120 Smith dynamically maps target users with identifying data that has been acquired within the information repository)**

14. determining billing totals regarding the dialogue content according to the billing criteria and reporting billing totals to the destination address for the dialogue content  
**(Pg. 4 ¶ 63 and Pg 7 ¶113 Smith teaches calculating a price for the requested survey and requesting and entering payment information)**

15. Smith fails to teach storing the dialogue content received at the one or more destination addresses; and outputting the dialogue content at the one or more destination addresses corresponding to the extracted dialogue scenario. However, Nanos teaches the dialogue content stored at the destination and output at the destination(C. 7 I. 63-67). It would have been obvious to one of ordinary skill in the art the time of invention to combine Nanos destination storage and output with Smith's survey process as the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Additionally, be allowing the destination(or survey

developer) maintain the information themselves this would allow them to use the data how they wished for presentations or further analysis.

16. As to claim 4 Smith teaches a dialog storing unit(Pg. 6 ¶ 99; Pg. 7 ¶ 115)

17. As to claims 8 and 11 Smith teaches compensation for the survey participant(Pg. 9 ¶ 139 Pg. 8 ¶ 127).

18. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith/Nanos as applied to claims 1, 2, 4, 7-11 above, and further in view of US Patent Publication 20020091569 Kitaura et al; Electronic coupon system, hereinafter referred to as Kitaura.

19. As to claims 5-6 Smith/Nanos fail to teach the following limitations; however Kitaura teaches:

20. further comprising a merchandise-specifying unit accepting input of merchandise identification data for identifying merchandise,(Pg. 3 ¶ 24 users entering product identification information)

21. wherein said scenario storage unit correspondingly assigns merchandise identification data to each of the dialogue scenarios, and stores as the destination addresses, communications addresses for providers of the merchandise identified by the merchandise identification data; wherein said extraction unit extracts the dialogue scenario corresponding to input merchandise identification data; and wherein said information transmission unit transmits the dialogue content to the communications addresses corresponding to the merchandise identification data (Pg. 9 L 137-139 conducts survey using usage information surveys for manufactures on persons who

purchased certain products and reports results to manufacture). It would have been obvious to one skilled in the art at the time of invention to combine the merchandise identifying step of Kitaura with the survey process of Smith/Nanos as it is merely a combination of old elements in the art of product survey/marketing and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized the results of the combination were predictable.

### ***Response to Arguments***

22. Applicant's arguments filed January 15, 2009 have been fully considered but they are not persuasive.

23. Applicant argues that the reference fails to teach the newly added limitations of billing criteria and determining and reporting billing totals. The examiner notes these limitations are simply those limitations of claim 7 brought into the independent claim. These limitations have been previously rejected. Applicant further fails to set forth evidence as to why the prior art of record fails to teach these limitations but rather simply repeats the claim language.

24. As to applicants arguments regarding the 112 2<sup>nd</sup> paragraph rejections. The examiner notes that for the purpose of prosecution and lack of further definition in the disclosure, "correspondence" are being treated as simply some form of information exchange. Therefore, as currently amended, the claim essentially reads storing information.



25. As to applicants arguments regarding the rejection of claim 1 under USC 101 applicants arguments are not persuasive. The applicant is reminded that in order for a method/process claim to pass muster the apparatus/machine must impart "meaningful limits" on the claims scope. The involvements must be more than storing, gathering sending and receiving data. Additionally, nominal use in the preamble does not positively claim what part of the method/process is being performed by a machine/apparatus.

### ***Conclusion***

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traci L Casler/  
Examiner, Art Unit 3629

/JOHN G WEISS/  
Supervisory Patent Examiner, Art Unit 3629